

USSN: 10/760,326
Response to Office Action Dated 04/17/2006

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REMARKS

Claims 1-30 are currently before the Examiner. Claims 1, 16-17, 20, 22, and 26-27 have been amended, and claims 8-9, 14-15, 18-19 and 28-30 have been cancelled herein.

Claims 1-30 stand rejected under 35 U.S.C. 112, 1st paragraph, for failing to comply with the enablement requirement. The rejection is respectfully traversed.

The office action states the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or which is most nearly connected, to make and/or use the invention. Specifically, the office action states there is nothing in the specification to show the composition of the ester compound or the way the ester compound is formed in the reaction of the diene, the dienophile and the carboxylic acid. The ingredients claimed do not comprise a hydroxyl group, essential for the formation of an ester. One of ordinary skill would not know how to get at least 5% or 10% ester compound from the above reaction.

In response, applicants state that, although ester compounds can be produced by a condensation reaction between an acid and an alcohol, it is also known in the art that ester compounds may be produced by an addition reaction between an acid and an olefin. In the present case, the rosin is the acid and the diene and dienophile are the olefin. Please see, for example, the disclosure of US Pat. No. 6,946,570.

Claims 8, 9, 17, 19 and 22-25 stand rejected under 35 U.S.C. 112, 2nd paragraph, for failing to particularly point out and distinctively claim the subject matter regarded as the invention. The rejection is respectfully traversed.

Specifically, the office action states there are no inorganic carboxylic acids (claim 8). Claims 9 and 17 are indefinite because of the phrase "a derivative of a rosin acid." Acrylics are not

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hydrocarbons (claim 19). Claims 22-25 omit essential elements of matrix polymers and a tackifier by itself is not an adhesive.

In response, applicants have cancelled claims 8 and 9. Applicants have amended the remaining claims to delete the phrase "a derivative of a rosin acid." Applicants have also cancelled claims 15 and 19 which contained the phrase "an acrylic hydrocarbon or a mixture thereof." Applicants have further amended claim 22 so that the adhesive composition comprises the resin composition of claim 1.

Claims 1-30 stand rejected under 35 U.S.C. 102(b) as anticipated by, or in the alternative under 35 U.S.C. 103(a) as obvious over Laurito (US Pat. No. 4,433,100) or Reichhold Chemicals Inc. (EP 300624). The rejection is respectfully traversed.

Specifically the office action states that Laurito discloses the reaction product of dicyclopentadiene, a hydrocarbon and a fatty acid or a rosin acid in claims 1-7. The hydrocarbon can be cyclic olefins (claims 11, 14, 17, 18 and 20). For terpenes, see col. 11, lines 19-23. Dicyclopentadien concentrations are shown in col. 4, lines 65-69, hydrocarbon concentrations in col. 28, lines 25-33 and acid concentrations in col. 30, lines 13-29. Acid numbers are in col. 32, lines 29-56.

In response, applicants initially have amended the independent claims to further define the dienophile an aromatic vinylic hydrocarbon. Laurito is directed to resin compositions for printing inks comprising a predominate amount of cyclopentadiene, at least one hydrocarbon having no aromatic rings and a fatty acid-containing material or a rosin acid-containing material. Reichhold is directed to polymers of cyclopentadiene, with or without other olefins,

The resin composition of the present invention differs from Laurito in that it requires the presence of an aromatic vinylic hydrocarbon. Laurito requires the absence of aromatic rings and therefore does not teach the resin composition of the present invention. Laurito does not teach or suggest that such a resin composition would result in improved tack and peel.

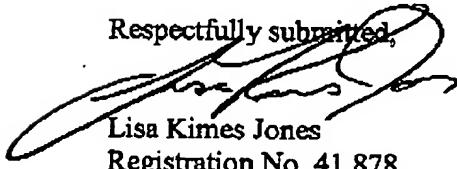
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The office action states that Reichhold teaches a reaction product of dicyclopentadiene, styrene and rosin acid or maleic anhydride or acrylic acid having an acid number of 10-150 in claims 1-3. For disproportionate rosin, see Example 15. Concentrations and preferred acid numbers are shown on page 3, lines 17-22. Acid concentrations may be found in the Examples. There is no ester compound shown in applicants' examples so it must be inherent in the reaction. All properties are inherent in the composition and/or the process. In the alternative, it would have been obvious to select applicants' dienophiles from a list of equivalents.

In response, applicants state that Reichhold is directed to polymers of cyclopentadiene with or without other olefins which have been reacted with carboxylic acids to yield resins having carboxyl functionality. Reichhold utilizes a disproportionate rosin in Example 15, formulation B, as a comparative. Reichhold does not teach or suggest reacting a diene, an aromatic vinylic hydrocarbon and a rosin acid in the presence of a disproportionation agent. Example 3 of Reichhold is reproduced in the present specification (resin 2). As illustrated in the Examples, the compositions of the present invention exhibit improved tack and peel when compared to those prepared in accordance with Reichhold. Therefore, the reference does not teach the resin composition of the present invention, prepared in the presence of a disproportionation agent, nor that such a resin composition would result in improved tack and peel.

In light of the above, it is respectfully submitted that the currently pending claims of the present application are in condition for allowance. If it would be of any assistance with this application, the Examiner is invited to contact the undersigned.

Respectfully submitted,


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Date: 9-18-2006

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